

REMARKS

Summary of the Amendment

Upon entry of the above amendment, the claims 1, 18, 24, 25 and 31 will have been amended, claim 10 will have been canceled and claims 32-34 will have been added. Support for the amendment to claims 1, 24, 25 and 31 can be found on paragraphs [0024] – [0027] of the instant specification. Accordingly, claims 1-9, 11-28 and 31 will be pending with claims 1, 18, 25 and 31 being in independent form. Reconsideration of the Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Telephone Interview of September 12, 2005

In the Interview of September 12, 2005, Applicants' representative pointed out that OLGADO fails to disclose or suggest accelerating the workpiece while the workpiece is gripped, much less, doing so with all of the plurality of contacts or gripping mechanisms alone, or in combination with, after the workpiece has reached a desired speed, either alternately moving the plurality of contacts or gripping mechanisms between gripping positions and release positions, or moving alternate gripping mechanisms of the plurality of gripping mechanisms away from and into contact with the workpiece during processing, or after the workpiece has reached a desired speed. In response, the Examiner did not disagree and indicated that if the claims are so amended and if, after he carefully reviews the applied document, the applied document

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does not in fact disclose or suggest these features, he would reconsider the current prior art rejections. The Examiner also indicated that because Applicants were under final rejection, he would consider such an amendment to the claims as raising new issues.

35 U.S.C. § 102(e) Rejection

Claims 1-2, 9, 12, 14-18, 24-28 and 31 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,689,418 to OLGADO et al.

The Examiner asserted that this document discloses or suggests all the features recited in these claims including processing a workpiece on a device which includes independently actuatable contacts 72 and 73. Applicant respectfully traverses this rejection.

Notwithstanding the Office Action assertions as to what OLGADO discloses, Applicant submits that OLGADO fails to disclose, or even suggest, for example, accelerating the workpiece while the workpiece is gripped with all of the plurality of contacts or gripping mechanisms (claims 1, 18, 25 and 31) and after the workpiece has reached a desired speed, either alternately moving the plurality of contacts or gripping mechanisms between gripping positions and release positions (claims 1 and 18), or moving alternate gripping mechanisms of the plurality of gripping mechanisms away from and into contact with the workpiece during processing (claim 25), or after the workpiece has reached a desired speed, processing a surface of the workpiece (claim

31).

While Applicant does not dispute that OLGADO discloses that the gripping fingers are used to secure the workpiece “during the spinning operation” and that first and second sets of fingers can be actuated during first and second cleaning periods (see col. 5, line 58 to col. 6, line 14), it is clear from a fair reading of OLGADO that this document clearly does not disclose, or even suggest, accelerating the workpiece while the workpiece is gripped, much less, doing so with all of the plurality of contacts or gripping mechanisms. Indeed, the Examiner has acknowledged as much on page 4 of the Office Action dated December 15, 2004. Finally, it is clear that OLGADO lacks any disclosure or suggestion indicating that after the workpiece has reached a desired speed, either alternately moving the plurality of contacts or gripping mechanisms between gripping positions and release positions, or moving alternate gripping mechanisms of the plurality of gripping mechanisms away from and into contact with the workpiece during processing, or after the workpiece has reached a desired speed, processing a surface of the workpiece.

Thus, Applicant submits that the above-noted claims are not disclosed, or even suggested, by any proper reading of OLGADO.

Moreover, Applicant submits that dependent claims 2, 9, 12, 14-17 and 24 are allowable at least for the reason that these claims depend from allowable base claims and because these claims recite additional features that further define the present invention. In particular, Applicant submits that no proper reading of OLGADO discloses

or even suggests, in combination, the features recited in claims 2, 9, 12 and 14-17 in combination with the features recited in claim 1, the features recited in claim 24 in combination with the features recited in claim 18, and the features recited in claims 26-28 in combination with the features recited in claim 25. Applicant notes, for example, that, contrary to the Examiner's assertions in the Office Action, OLGADO does not disclose or suggest the separately releasing and engaging of the contacts in alternate order recited in claim 12. Instead, OLGADO merely discloses that one alternating set of contacts 72 can be released from the workpiece while another alternating set of contacts 73 engages the workpiece.

Applicant requests that the Examiner reconsider and withdraw the rejection of the above-noted claims under 35 U.S.C. § 102(e).

35 U.S.C. § 103(a) Rejection

Claims 3-8, 10, 11, 13 and 19-23 were rejected under 35 U.S.C. § 103(a) as unpatentable over OLGADO alone.

The Examiner acknowledged that OLGADO lacks, among other features, the recited number of gripping mechanisms/contacts, the accelerating of the chuck, and the sequence of movement of the gripping mechanisms/contacts. However, the Examiner asserted that such features would have been obvious to one of ordinary skill in the art. Applicant respectfully disagrees with the Examiner's assertions and traverses this rejection.

Notwithstanding the Examiner's assertion as to what OLGADO discloses or suggests, Applicant submits that in addition to failing to anticipate the invention recited in amended independent claims 1 and 18, OLGADO also fails to teach or suggest the invention recited in at least the independent claims 1 and 18. Applicant respectfully submits that the recited features, in combination with the other features recited in claims 1 and 18, would not have been obvious to one having ordinary skill in the art and, furthermore, the recited features constitute aspects of the invention which is not merely a matter of design or optimized parameters.

Applicant directs the Examiner's attention to the guidelines identified in M.P.E.P. section 2141 which state that

"[i]n determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

As this section clearly indicates,

"[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

Moreover, it has been legally established that

"[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

.... Although a prior art device □ may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so. □ 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references)."

Additionally, it has been held that

"[a] statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)."

Moreover, Applicant submits that there is no motivation to modify OLGADO in a manner which would render obvious Applicant's invention, and additionally, Applicant submits that there is no motivation or rationale disclosed or suggested in the prior art to modify the applied reference in the manner suggested by the Examiner. The Examiner's opinion does not provide a proper basis for these features or for the motivation to modify this document in the manner suggested by the Examiner. Therefore, Applicant submits that the invention as recited in at least independent claims 1 and 18 is not rendered obvious by any reasonable inspection and interpretation of the disclosure of the applied reference.

Furthermore, Applicant submits that the rejection of claim 10 is moot inasmuch as claim 10 has been canceled and that dependent claims 3-8, 11, 13, 19-23 are allowable at least for the reason that these claims depend from allowable base claims and because these claims recite additional features that further define the present

invention. In particular, Applicant submits that no proper reading or modification of OLGADO discloses or suggests, in combination: the features recited in claims 3-8, 11 and 13 in combination with the features recited in claim 1, and the features recited in claims 19-23 in combination with the features recited in claim 18. Applicant notes, for example, that, contrary to the Examiner's assertions in the Office Action, OLGADO does not disclose or suggest the separately releasing and engaging of the contacts in sequential order recited in claim 11. Instead, OLGADO merely discloses that one alternating set of contacts 72 can be released from the workpiece while another alternating set of contacts 73 engages the workpiece.

Applicant requests that the Examiner reconsider and withdraw the rejection of the above-noted claims under 35 U.S.C. § 103(a).

CONCLUSION

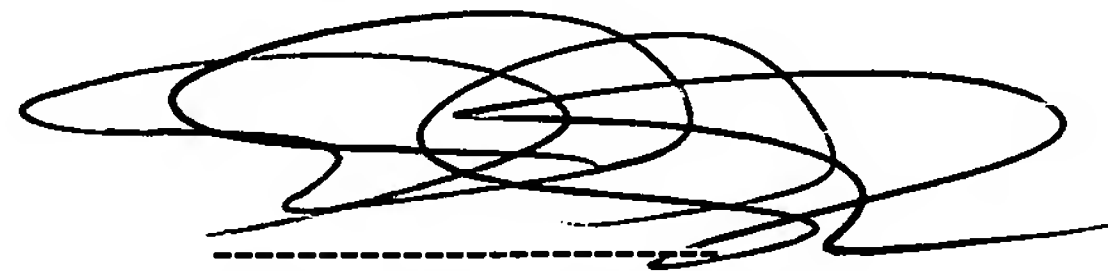
In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious the Applicant's invention, as recited in each of the pending claims. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out. Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed

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to attach thereto. Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Authorization is hereby given to refund excess payments and charge any additional fee necessary to have this paper entered to Deposit Account No. 09-0458.

Respectfully submitted,
F. W. KERN Jr.

A handwritten signature in black ink, appearing to read 'Andrew M. Calderon', written over a horizontal dashed line.

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